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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/342,280 06/29/99 HEIMAN

STEPHEN M HEIMAN
212 LOUIS DRIVE
EXTON PA 19341

MMC2/1218

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| EXAMINER |
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| ART UNIT | PAPER NUMBER |
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DATE MAILED:

12/18/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/342,280

Applicant(s)

Helman et al.

Examiner
Jeann -Marguerite Goodwin

Group Art Unit
2859



☒ Responsive to communication(s) filed on Jun 29, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-20 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Jun 29, 1999 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the second timer as stated in claims 2, 9, and 15, the voice recognition software as stated in claims 4 and 11, and the frequency detection software as stated in claims 5 and 12 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Specification

2. The entire disclosure, i.e. specification, claims and abstract, should be revised carefully to correct any grammatical and idiomatic errors which may be present.

Claim Rejections - 35 USC § 112

3. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-3, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claims 4-7 are rejected to as being dependent upon a rejected claim.

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Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Costabile in view of Hegarty et al. [hereinafter Hegarty].

Costabile discloses a sports timing apparatus comprising a timer, a remote control means by wireless communication, a controller 20 which starts and stops the timer when the remote control means are activated by a whistle or audible signaling devices of other frequencies, the remote control means comprises one or more switches 5a, 5b, 5c, 26a, 26b and 26c, transmitters 4a, 4b and 4c and receivers 11a, 11b and 11c, microphones 3a, 3b and 3c, frequency detection means (high and low band filters 16 and 17) and a visual display that displays remaining time on the timer. Costabile discloses all the claimed subject matter with the exception of the limitations stated in claim 1, i.e. the intended use of the apparatus, a storage device, an electro-acoustics device, and a processor which selects audio files at predetermined times and passes the audio files to the electro-acoustics device; the limitation stated in claim 2, i.e. a second timer; and the limitation stated in claim 6, i.e. the audio files being stored digitally.

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With respect to the intended use of the apparatus, i.e., for interactively timing an amateur sports game: It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

With respect to the storage device, the electro-acoustics device, and the processor which selects audio files at predetermined times and passes the audio files to the electro-acoustics device: Hegarty discloses an apparatus comprising a system controller 10, a loud speaker 19 and audio information stored appropriately in compact discs or programmable read-only memories 18 and 18' in order to permit a plurality of audio signals to be synchronized with selected time events and to be broadcast, respectively. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the controller of Costabile, by the controller, as taught by Hegarty and add the storage device and loudspeaker, as taught by Hegarty, to Costabile in order to permit a plurality of audio signals to be synchronized with selected time events and to be broadcast as already suggested by Hegarty. Inherently, Hegarty's system controller 10 selects audio files at predetermined times and passes the audio files to the loudspeaker 19.

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With respect to the second timer: It has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8.

With respect to the audio files being stored digitally: Hegarty discloses an apparatus having an A/D converter 33 in order to convert an analog signal to a digital signal to be stored and processed, respectively. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add an A/D converter, as taught by Hegarty, to the apparatus of Costabile in order to convert an analog signal to a digital signal to be stored and processed, respectively, as already suggested by Hegarty.

With respect to the preamble of the claim: the preamble of the claim has not been given any patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. Kropa v. Robie, 88 USPQ 478 (CCPA 1951).

6. Claims 4 and 14-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Costabile and Hegarty as applied to claims 1-3 and 5-7 above, and further in view of JP 357063467.

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Costabile and Hegarty discloses all the claimed subject matter with the exception of the limitation stated in claim 4, i.e. the voice recognition software.

With respect to the voice recognition software: JP 357063467 discloses a timing device comprising a voice recognition and a voice synthesis unit in order for vocal messages to be broadcast, respectively. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add the voice recognition and the voice synthesis unit, as taught by JP 357063467, to Costabile and Hegarty, in order for vocal messages to be broadcast, respectively, as already suggested by JP 357063467. Furthermore, the voice recognition and the voice synthesis unit obviously contains the voice recognition software.

The method claims 14-20: the method steps will be met during the normal assembly of the device stated above.

7. Claims 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Costabile in view of JP 357063467.

Costabile discloses a device as stated above in paragraph 6. Costabile discloses all the claimed subject matter with the exception of the limitations stated in claim 8, i.e. the intended use of the apparatus, a storage device, an electro-acoustics device, and a processor which selects

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voice files at predetermined times and passes the voice files to the electro-acoustics device; the limitation stated in claim 9, i.e. a second timer; and the limitation stated in claim 11, i.e. a voice recognition software.

With respect to the intended use of the apparatus, i.e., for interactively timing an amateur sports game: It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

With respect to the storage device, the electro-acoustics device, and the processor which selects voice files at predetermined times and passes the voice files to the electro-acoustics device: JP 357063467 discloses a device having a storage section 7, a speaker, a voice recognition and a voice synthesis unit and a control section 2, which inherently selects voice files at predetermined times and passes the voice files to the speaker. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the controller of Costabile, by the control section, as taught by JP 357063467 and add the storage device, the speaker, the voice recognition and the voice synthesis unit as taught by JP 357063467, to Costabile, in order for vocal messages to be broadcast, respectively. Furthermore, the voice recognition and voice synthesis unit obviously contains the voice recognition software.

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With respect to the second timer: It has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8.

With respect to the preamble of the claim: the preamble of the claim has not been given any patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. Kropa v. Robie, 88 USPQ 478 (CCPA 1951).

Inventorship

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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Conclusion


9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited in the PTO-892 disclose related device and methods. Aihara discloses a device including an acoustic data recording/reproducing functions related to time measurements; JP 363098586 discloses a time measuring device having voice tone detection capability; JP 404140689 discloses a vocal announcing device of time; Rose et al. discloses a device incorporating primary and secondary timers; and Jetter discloses a remote controlled alarm clock.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeanne-Marguerite Goodwin whose telephone number is (703) 305-0264. The examiner can normally be reached on Monday-Friday from 8:00 AM to 4:00 PM.

The fax phone number for the organization where this application or proceeding is assigned is (703)308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.

JMG
Dec. 13, 2000


BERNARD ROSKOSKI
PRIMARY PATENT EXAMINER
TECHNOLOGY CENTER 2800